

**Neifeld Docket No:** CAT29US-SCRCO3

Application/Patent No: 09/756,788

USPTO CONFIRMATION NO: 6599

File/Issue Date: January 10, 2001

Inventor/Title: MICHAEL C. SCROGGIE ET AL./System and Method for Providing Shopping Aids and Incentives to Customers Through a Computer Network

Examiner/ArtUnit: JANVIER/3688

ENTITY STATUS: LARGE

**37 CFR 1.7(c) FILING RECEIPT AND TRANSMITTAL LETTER WITH  
AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT**

**1. THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE ANY FEES  
WHICH MAY BE REQUIRED, OR CREDIT ANY OVERPAYMENT, TO DEPOSIT  
ACCOUNT NUMBER 50-2106.**

**2. FEES PAID HERewith BY EFS CREDIT CARD SUBMISSION: \$0**

**A. CLAIMS FEES**

0.00 \$ - ( claims previously paid for; currently present; \$50 per addl. claim over 20.)

0.00 \$ - ( independent previously paid for; currently present; \$200 per addl. claim over 3)

**B. OTHER FEE \$**

**3. THE FOLLOWING DOCUMENTS ARE SUBMITTED HERewith:**

37 CFR 41.41 Reply Brief

**4. FOR INTERNAL NEIFELD IP LAW, PC USE ONLY**

USPTO CHARGES: \$ CLIENT BILLING MATTER: CAT29USSCRO BANK ACCOUNT/Check: G/L ACCOUNT:	FIRM CHARGES: \$ DESCRIPTION: FIRM CHARGE FOR LAWYER: RAN
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INITIALS OF PERSON WHO **ENTERED** ACCOUNTING DATA:

ATTORNEY SIGNATURE (AUTHORIZING DEPOSIT ACCOUNT)

**DATE:** 6/2/2009

**SIGNATURE:** /RichardNeifeld#35,299/  
RICHARD NEIFELD, REG. NO. 35,299

Printed: June 2, 2009 (1:05pm)

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37 CFR 41.41 REPLY BRIEF

## **REMARKS**

The examiner's answer does not address the rejections of the claims now pending. Those claims are those presented in the appeal brief filed 10/23/2008 which were presented in the amendment filed September 29, 2008.

Since the examiner's arguments are not directed to the pending claims, the examiner has not presented a prima facie case for any rejection. Accordingly, the rejections should be reversed.

The reasoning why the claims pending are those shown in the appeal brief filed 10/23/2008 which were presented in the amendment filed September 29, 2008 are presented in the petition filed 6/2/2009, the text of which is copied below.

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### **I. STATEMENT OF RELIEF REQUESTED**

The applicant requests that the Director, again, instruct the Examiner to respond to the amendment filed 9/29/2008.

### **II. STATEMENT OF MATERIAL FACTS IN SUPPORT OF THE PETITION**

0. Incorporations by reference. The following documents are in the IFW for this application. They are expressly incorporated by reference herein in case further action by the applicant is required.

The prior petition, filed January 30, 2009, is incorporated by reference herein.

The decision dated April 10, 2009 on petition filed January 30, 2009, is incorporated by

reference herein.

The petition dated 5/26/2009 for review of April 10, 2009 decision of the Technology Center Director by USPTO Director, is incorporated by reference herein.

The paper title "RESPONSE TO 1/26/2009 NOTIFICATION OF NON COMPLIANT APPEAL BRIEF", filed 1/30/2009, is incorporated by reference herein.

The paper titled "Examiner's Answer", dated 5/29/2009, is incorporated by reference herein.

1. On 1/27/2009, the office mailed a paper signed by Examiner Janvier, Notice of Non Compliant Appeal Brief. This paper improperly states that:

This Application is not in condition for Appeal. Indeed, the filing of an Appeal Brief in the Instant Application is premature. On 09/17/08, the Office mailed a Non-Final Action to the Applicant. On 09/29/08, the Applicant filed a request for reconsideration, under 37 CFR 1.111, consisting of a claim amendment and arguments. Even before, the Examiner issues a response to the 1.111 reply, Applicant filed on 10/23/08 a Notice of Appeal together with an Appeal Brief. Here, the Applicant can either render the 1.111 reply null and void to thereby proceed with the Appeal Brief after updating the said Appeal or withdraw the Appeal and have the 1.111 reply considered by the Examiner.

This is the sixth instance of impropriety in this case.

2. On 1/30/2009, the applicant filed a paper complying with the 1/27/2009 notice, with traverse, only because failure to do so would have resulted in the examiner improperly holding the application abandoned, pursuant to the 1/27/2009 Notice deadline, 2/26/2009. That paper stated in relevant part that:

I. PROVISIONAL RESPONSE, WITH TRAVERSE

The applicant traverses the requirement in the 1/26/2009 Notification of Non Compliant Appeal Brief as improper and requests reconsideration and withdrawal of the notification.

The applicant also responds to the requirement in the notice in order to avoid an improper abandonment of the application due to failure to respond to the improper requirements in the Notification. The Notification states that:

This Application is not in condition for Appeal. Indeed, the filing of an Appeal Brief in the Instant Application is premature.

On 09/17/08, the Office mailed a Non-Final Action to the Applicant. On 09/29/08, the Applicant filed a request for reconsideration, under 37 CFR 1.111, consisting of a claim

amendment and arguments. Even before, the Examiner issues a response to the 1.111 reply, Applicant filed on 10/23/08 a Notice of Appeal together with an Appeal Brief. Here, the Applicant can either render the 1.111 reply null and void to thereby proceed with the Appeal Brief after updating the said Appeal or withdraw the Appeal and have the 1.111 reply considered by the Examiner.

With traverse, the applicant "render the 1.111 reply null and void to thereby proceed with the Appeal Brief after updating the said Appeal or withdraw the Appeal". The office action dated 9/17/2008 was in response to the communication of "17 October 2006". Office action item 1. The communication the applicant filed 17 October 2006 consisted of the following two papers:

(1)RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

(2) 37 CFR 41.37 FOURTH SUPPLEMENTAL APPEAL BRIEF

The applicant elects to proceed with the appeal brief filed 17 October 2006, without updating the appeal brief. The applicant believes that action will most promptly result in decision on the petition filed 1/30/2009 thereby expediting a decision on the merits of the application.

3. On 1/30/2009, the applicant also filed a petition to invoke supervisory authority of the Director to, inter alia, have the 1/27/2009 Notice of Non Compliant Appeal Brief withdrawn.

4. On 4/10/2009, the USPTO mailed a decision of the technology center director on the 1/30/2009 petition. That decision in pertinent part stated that:

4.1 "The reply filed September 29, 2008 was fully responsive to the September 17, 2008 non-final rejection and in compliance with 37 CFR 1.111(b). Accordingly it was a proper reply."

4.2 "Petitioner's request to withdraw the Notice of Non-Compliant Appeal Brief is GRANTED. Accordingly, the Notice is hereby withdrawn."

4.3 "Accordingly, the application is being forwarded to the examiner for consideration of the September 29, 2008 amendment. An Office action will be mailed in due course. Applicant may then file a notice of appeal."

4.4 "Petitioner further "elects to proceed with the appeal brief filed 17 October 2006, without updating the appeal brief." Applicant's request is not granted. In reply to the October 17, 2006 appeal brief, the examiner reopened prosecution and issued a non-final Office action on September 17, 2008. Accordingly, the issues set forth in the October 17, 2006 appeal brief are no longer pending."

5. The examiner's answer dated 5/29/2009 has not considered the amendment filed September 29, 2008. Instead, it considers the version of claims presented in the October 16, 2009 appeal brief. The examiner's answer dated 5/29/2009 stated in pertinent part that:

5.1 "The version of claims 32-91, filed on April 17, 2003, pending at the time the Non-Final Action was issued is herein being appealed." Examiner's answer page 2.

5.2

The Appellant, on January 30, 2009, had filed a reply in the form of a petition to the "defective Appeal Brief" and correctly argued that the Application was in condition for Appeal for the claims had been rejected many times (more than twice) and agreed to "render the 1.111 reply null and void" or simply cancel the 1.111 reply to thereby proceed with the Appeal Brief filed on October 23, 2008 (See page 4 of the said response-3rd paragraph). Furthermore, it appears that the Appellant had elected to rather proceed with the old Appeal Brief, filed on October 17, 2006, since the last Office Action was a response to the filing of the old Appeal Brief. The rest of the Appellant's remarks in the petition is beyond the scope of the Examiner's Answer. Additionally, the petition was granted in part, on April 10, 2009, agreeing with the Appellant that the Application was indeed in condition for Appeal and the Examiner will proceed with the Examiner's Answer as shown below. [Examiner's answer pages 2 and 3.]



### **III. REASONS WHY THE RELIEF REQUESTED SHOULD BE GRANTED**

#### **A. SUMMARY**

In summary, the claims pending are those contained in the September 29, 2008 amendment. The examiner's answer assumes that a prior version of the claims is pending and does not address the pending claims.

#### **B. REASONING**

The technology center Director's decision dated 4/10/2009 noted that the amendment filed September 29, 2008 was proper and instructed the examiner to consider it. Facts 4.1 and 4.3. However, the examiner's answer fails to consider that amendment. Fact 5.1.

The technology center Director also withdrew the 1/27/2009 Notice of Non-Compliant Appeal Brief, as improper, and noted that applicant's response with traverse to that notice, which was to proceed with the appeal on the appeal brief filed 17 October 2006 was not granted, further clarifying that the examiner should instead consider the amendment filed September 29, 2008. Facts 4.2 and 4.4. In fact, as noted in the applicant's response to the Notice of Non-Compliant Appeal Brief, that election to proceed with the appeal brief filed 17 October 2006 was only to avoid abandonment for failure to comply with a PTO requirement, in the expectation that the requirement would be withdrawn, as improper.

The examiner's answer concludes that the claims in the 17 October 2006 are pending, and that the applicant's provisional election with traverse in response to the now withdrawn Notice of Non-Compliant Appeal Brief, is in effect. Neither conclusion is true. As noted above, the technology center Director made it perfectly clear that both the Notice of Non-Compliant Appeal Brief was withdrawn and the applicant's provisional election to proceed with an old

appeal brief, with traverse, in response to the improper Notice, were ineffective. Facts 4.2 and 4.4.

The examiner's action is procedurally improper because it does not respond to the pending claims and because it alleges that an older version of the claims are pending. Both improprieties need to be corrected to set the record straight and to avoid yet further delays in the application.

**DATE:** 6-2-2009

**SIGNATURE:** /RichardNeifeld#35,299/

Registration No. 35,299

Attorney of record

RAN

June 2, 2009 (1:05pm)

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